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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,769	07/12/2001	Mary E. Goulet	07220001AA	1347

30743 7590 07/27/2004

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EXAMINER	
BORISSOV, IGOR N	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/902,769	GOULET, MARY E.	
	Examiner	Art Unit	
	Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 July 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-7, 9 and 14-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsukawa (US 2002/0042017 A1).

Matsukawa teaches advertisement distribution method and system, comprising:

Claim 1. Providing access to a musical piece (creative work) over the Internet [0004]; [0011]. Further, Matsukawa teaches advantages of distributing an advertisement electronically in comparison to distributing a permanent non-paper announcement item, such as a towel, having the company information printed on said towel [0013]. Information as to *optionally updating and/or revising the site one or more times* is non-functional language and given no patentable weight.

Claim 2. See claim 1. Information as to *a beach* towel is non-functional language and not given patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Narang would be performed the same regardless of the type of the towel.

Claim 3. Same reasoning as in claim 1.

Claim 4. See claim 1. Information as to *a new musical theater work* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Narang would be performed the same regardless of the type of the musical work.

Claim 6. Same reasoning as in claim 1.

Claim 7. Providing printed information on the towel inherently indicates providing *observable by others* information on the towel.

Claim 9. Said method, wherein the site includes a musical piece [0004].

Claim 14. Matsukawa teaches advantages of distributing an advertisement electronically in comparison to distributing a permanent non-paper announcement item, such as a towel, having the company information printed on said towel [0013]. Information as to *an Internet domain name relating to a creative-work, wherein the name represents a publically accessible active Internet site on which appears content relating to the creative-work* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claim 15. See claim 14. Information as to *beach towel* and *the creative-work is a musical theater show* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsukawa in view of Deitrickson (US 2002/0165797 A1).

Claims 5 and 18-19. Matsukawa teaches all the limitations of claims 5 and 18-19, except teaching that *tickets for a new musical theater work can be purchased over the Internet.*

Deitrickson teaches an interactive marketing method and system, wherein a consumer uses a Web site to purchase tickets for concerts [0037].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Matsukawa to include *purchasing tickets for a new musical theater work over the Internet*, as disclosed in Deitrickson, because it allow the consumer to purchase said tickets at any convenient for him/her time at home.

Claim 20. See clam 19. Information as to *purchasing of tickets to attend a performance and/or purchasing of the creative-work* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 20 are disclosed in Matsukawa in view of Deitrickson as

described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsukawa in view of Sheppard, JR. (US 2003/0131901 A1).

Claims 8 and 16. Matsukawa teaches printing company information onto towels [0013].

Matsukawa does not specifically teach that printing includes *embroidering* company information onto the towels.

Sheppard, JR. (hereinafter Sheppard) teaches a method for making woven textile with graphic impression, including a towel having names and messages embroidered thereon [0005].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Matsukawa to include *embroidering* company information onto the towels, as disclosed in Sheppard, because embroidered messages have a neater and more appealing appearance, as specifically taught in Sheppard [0005]. Information as to *the Internet site address* is non-functional language and given no patentable weigh. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claims 10-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsukawa in view of Newman (US 2002/0069176 A1).

Claim 10. Matsukawa teaches all the limitations of claim 10, except *including a statement informing someone listening to the sample clip how to find a full-recorded version.*

Newman teaches a method and system for obtaining fee-based data and services over the Internet, wherein a sample of data is provided for a user, and, if the user elects to obtain a full version of the sampled data, the full version is provided in exchange for a payment [0041].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Matsukawa to include *providing a user with ability to obtain a full version of the musical piece after listening to the sample*, as disclosed in Newman, because it would allow a musical piece owner to sell the product, thereby generate revenue.

Claim 11. Newman teaches that Web page includes sound content, movie, pictures, or text, and any combination thereof [0049]; [0051]. Information as to the specific content of the Web page is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* Furthermore, information as to *quality of a sample is lower than that of a full version* is well known in the art. See, for example, Edwards et al. (US 2001/0037319 A1); [0019].

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsukawa in view of Weight (US 2003/0023638 A1).

Claim 12. Matsukawa teaches all the limitations of claim 12, except specifically teaching that *the Web site is updated more frequently than quarterly.*

Weight teaches a method and system for processing content, including a Web page displaying information related to music samples and movie reviews, wherein said information is updated daily [0003]; [0021].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Matsukawa to include *updating the Web page content*

daily, as disclosed in Weight, because it would provide users with up-to-date information, thereby increase traffic and possible revenue.

Claims 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsukawa in view of Sherman et al. (US 2002/0051119 A1).

Claims 13 and 17. Matsukawa teaches all the limitations of claims 13 and 17, except teaching *filing a copyright application relating to the musical piece before the musical piece is included on the site*.

Sherman et al. (hereinafter Sherman) teaches a method and system for customizing a motion film selection, wherein, when a soundtrack of a movie is downloaded from a Web page, watermark technology is used to protect copyrighted material [0032], thereby obviously indicating *filing a copyright application relating to the musical piece before the musical piece is included on the site.*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Matsukawa to include *filing a copyright application relating to the musical piece before the musical piece is included on the site*, as disclosed in Sherman, because it would allow an author of the musical piece to collect revenue for use of his/her art work.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

The best foreign art located by the examiner is JP409154762A to Jinno, teaching a towel provided with a message embroidered thereon.

Examiner suggests the Applicant review documents cited in the form PTO-892 before submitting any amendment.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

JOHN G. WEISS
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